

REMARKS

Claims 1, 12-18 and 20 are currently pending in this application. In view of the following remarks, Applicant respectfully requests reconsideration of pending Claims 1, 12-18 and 20.

35 U.S.C. § 103 Rejections

Poss et al.

The Examiner has rejected claims 1, 16-18 and 20 under 35 U.S.C. § 103(a) for obviousness over U.S Patent Publication No. 2004/0091813 to Poss et al. (hereinafter '813). Applicant respectfully traverses.

Specifically, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to prepare the material of the reference choosing to employ the polymer having a norbornene-type monomer (A) and/or the monomer of the instant formula E as instantly claimed since '813 discloses a fluorinated polymer which may comprise an oligomer such as a norbornene-type monomer (instant formula A) and a monomer falling within the scope of the instant formula E that appear to meet the instant claim limitations, ([0009], [0010], [0034] - $R_f(CH_2)_pCXf=Cyf$, wherein X and Y are H, and R_f is perfluoroalkyl). The oligomer may be polymerized employing any known method, including employing a Ni or Pd catalyst ([0035]) and examples 5 and 6). Applicant disagrees.

For a rejection under 35 U.S.C. § 103(a) to be properly made and sustained, it is well established that "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (MPEP § 2143.03).

Applicant respectfully asserts that the Examiner has not properly construed the disclosure of '813 and thus Claims 1, 16-18 and 20 are patentable over it. Specifically, paragraph [0034] of '813 discloses a polymer that "may include one or more repeating units derived from other monomers, oligomers, or polymer compounds that have been copolymerized with at least one compound described by Formula I of the present invention. Suitable other monomers, oligomers, and polymer compounds include, for example, norbornene monomers, such as bicyclo[2.2.1]hept-5-ene-2-(1,1,1-trifluoro-2-trifluoromethylpropan-2-ol) (NBHFA),

ethylenically unsaturated compounds, especially those containing at least one fluorine substituent, and the like.” Thus the plain language of paragraph [0034] of ‘813 clearly states that the claimed polymer is copolymerized from repeating units that can be derived from three sources: (1) other monomers; (2) oligomers or (3) polymers. Further to the understanding of the nature of the three mentioned sources, paragraph [0034] suggests that NBHFA and ethylenically unsaturated compounds, especially those containing at least one fluorine substituent, are exemplars. Still further, paragraph [0034] provides specific examples of such exemplary ethylenically unsaturated compounds, none of which, Applicant asserts, are oligomers. Furthermore, paragraph [0034] of the Poss reference DOES NOT disclose any examples of suitable oligomers or polymers, but only suitable monomers. In view of the above, Applicant respectfully asserts that ‘813 does not teach or even suggest the oligomer as recited in Claim 1 of the instant application. Accordingly, the ‘813 application does not meet the requirement of MPEP § 2143.03 and withdrawal of the rejection and allowance of independent Claim 1 and Claims 16-18 and 20, which depend therefrom, are respectfully requested.

Matyjazewski et al.

Claims 12-15 stand rejected under 35 U.S.C. § 103(a) for obviousness over the Poss reference in view of U.S. Patent No. 6,512,060 to Matyjazewski et al. (hereinafter “the ‘060 patent”). Applicant respectfully traverses.

Specifically, the Examiner asserts that the Poss reference teaches that a conventional polymerization method may be employed to form the oligomer [0035], but that Poss does not teach the use of a radical polymerization method. The Examiner asserts that the ‘060 patent discloses a method of preparing polymers and/or oligomers employing a radical polymerization method (column 5, lines 47-52) and that given the teachings of these two references, it would be obvious to one of ordinary skill in the art to prepare the oligomers of Poss using the polymerization method of the ‘060 patent. Applicant disagrees.

Looking first to the Examiner’s allegation that ‘813 provides a teaching, or even a suggestion, of preparing an oligomer that reads on the oligomers of the instant application, Applicant reasserts the argument provided supra regarding the rejection over the ‘813 application taken alone. Further, Applicant asserts that the Examiner’s allegation that ‘813 teaches that “a

conventional polymerization method may be employed to form the oligomer [0035]” is factually incorrect. An electronic search of the Poss application reveals that the word oligomer only occurs twice in the application and that these two occurrences are limited to paragraph [0034], NOT [0035]. Rather paragraph [0035] states that “the **polymer** of the present invention may include one or more repeating units derived from other monomers, oligomers”. Thus the ‘813 application’s paragraph [0035], does not describe making or forming an oligomer, but rather a polymer that can include an oligomer as a repeating unit. It follows then that there is no support for the Examiner’s allegations in paragraph [0035] of ‘813.

However, if one assumes that the Examiner’s reference to paragraph [0035] was in error and that such reference should have been to [0034] where the word oligomer does appear, Applicant asserts that such paragraph is limited to teaching that a polymer of the invention, is formed employing any of the three sources for repeating units as argued supra.

Turning now to the ‘060 patent, the Examiner only asserts that this reference teaches a method of radical polymerization. The Examiner does not assert, nor does the patent contain, any reference to, teaching or suggestion of the oligomers of the instant invention. Therefore as it is has been shown that the ‘813 application does not teach or suggest forming the oligomers of the instant invention, and given that the ‘060 patent is also absent such a teaching or suggestion, it necessarily follows then that any combination of ‘813 and ‘060 CANNOT teach or suggest all of the limitations of Applicant’s Claims 12-16 as is required by MPEP § 2143.03, and whether or not the ATRP polymerization process taught by the ‘060 patent does not require comment. Accordingly, withdrawal of the rejection of Claims 12-15 and the allowance of such claims are earnestly sought.

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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that all of the pending claims in the present application are in condition for allowance as currently presented. Accordingly, reconsideration and withdrawal of the rejection and an early Notice of Allowance are respectfully requested.

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